

## **REMARKS**

Reconsideration of this application, as amended, is respectfully requested.

### **Status of related applications**

The Applicants wish to draw the Examiner's attention to the Applicants' related co-pending applications and issued patents (see Appendix A) directed to nanoparticles and methods of preparation and use thereof. One or more office actions have already issued in many of the listed cases.

### **Status of the Information disclosure statements**

The Applicants note that the Examiner still did not return the executed PTO 1449 form for the 6<sup>th</sup> Supp. Information Disclosure Statement (IDS) that was hand-delivered to the Examiner on September 9, 2002. A copy with the IDS with associated PTO 1449 form and a PTO stamped return postcard was attached to the Applicants' response to the prior Office Action dated May 29, 2003. A second copy of the aforementioned documents is attached. The Applicants request that the Examiner fully execute the PTO 1449 form for the 6<sup>th</sup> Supp. IDS and return a copy of the executed PTO 1449 form to the Applicants' undersigned representative. The Examiner is requested to contact the undersigned representative if the Examiner would like to have another copy of the references.

### **Status of the claims**

Claims 599-648 are pending in this application. Claims 599 and 620 were amended to further correct for obvious typographical errors. No new matter has been introduced into the application as a result of the present amendment. The Applicants respectfully submit that the amendment does not raise new issues and would not require any burdensome search to be performed by the Examiner. The Applicants further submit that the amendment places the claims into condition for allowance or in better form for consideration on appeal.

### **Rejection under 35 U.S.C. section 112, second paragraph**

Turning now to the Office action, claims 599-606 and 614-648 stand rejected under 35 U.S.C. section 112, second paragraph, for indefiniteness. Claims 607-613 were found to be allowable. The Examiner alleged that claim 599 recites a limitation for which there is insufficient antecedent basis in the claim. In view of the aforementioned amendment to the claim, the Applicants respectfully submit that

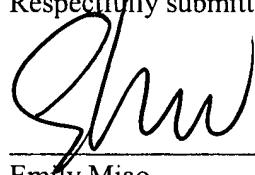
the rejection is now moot. Withdrawal of the section 112, second paragraph, rejection against claims 599-606 and 614-648 is in order and is respectfully requested.

### **Conclusion**

The Applicants thank the Examiner for the allowance of claims 607-613. The Applicants, however, respectfully submit that all of the remaining claims 599-606 and 614-648 in this application are also in allowable condition. A Notice to this effect is respectfully requested.

Reconsideration of this application is respectfully requested and a favorable determination is earnestly solicited. The Examiner is invited to contact the undersigned representative if the Examiner believes that this would be helpful in expediting the prosecution of this application.

Respectfully submitted,



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## APPENDIX A

ATTY Case No.	Serial No./ Filing Date	Inventors/Title	Status
00-653-G	U.S. 10/794,741 Filed 3/5/04	Mirkin, Letsinger, Mucic, Storhoff, Elghanian, Taton, Garamella, Li, Park/ NANOPARTICLES HAVING OLIGONUCLEOTI DES ATTACHED THERETO AND USES THEREFORE	ALLOWED
00-713-B1	09/923,625 Filed 8/7/01	Mirkin, Letsinger, Mucic, Storhoff, Elghanian/ NANOPARTICLES HAVING OLIGONUCLEOTI DES ATTACHED THERETO AND USES THEREFOR	ALLOWED
00-713-C	09/344,667, filed 6/25/99	Mirkin, Letsinger, Mucic, Storhoff, Elghanian/ NANOPARTICLES HAVING OLIGONUCLEOTI DES ATTACHED THERETO AND USES THEREFORE	U.S. Patent No. 6,361,944, issued 3/26/02
00-713-I	U.S.S.N 09/603,830 Filed 6/26/00	Mirkin, Letsinger, Mucic, Storhoff, Elghanian, Taton; NANOPARTICLES HAVING OLIGONUCLEOTI DES ATTACHED THERETO AND USES THEREFOR	U.S. Patent No. 6,506,564, issued 1/14/03
00-713-I-1	09/961,949 9/20/01	Mirkin, Letsinger, Mucic, Storhoff, Elghanian, Taton;	U.S. Patent No. 6,582,921, issued June 24, 2003

<b>ATTY Case No.</b>	<b>Serial No./ Filing Date</b>	<b>Inventors&gt;Title</b>	<b>Status</b>
		NANOPARTICLES HAVING OLIGONUCLEOTI DES ATTACHED THERETO AND USES THEREFOR	
<b>00-713-I-2</b>	09/957,318 9/20/01	See 00-713-I-1	U.S. Patent No. 6,759,199, issued 7/6/04
<b>00-713-I-3</b>	09/957,313 9/20/01	See 00-713-I-1	U.S. Patent No. 6,645,721, issued 11/11/03
<b>00-713-I-4</b>	09/966,491 9/28/01	See 00-713-I-1	U.S. Patent No. 6,610,491, issued August 26, 2003
<b>00-713-I-5</b>	09/966,312 9/28/01	See 00-713-I-1	U.S. Patent No. 6,673,548, issued January 6, 2004
<b>00-713-I-6</b>	09/967,409 9/28/01	See 00-713-I-1	U.S. Patent No. 6,740,491, issued May 24, 2004
<b>00-713-I-7</b>	09/974,500 10/10/01	See 00-713-I-1	U.S. Patent No. 6,709,825, issued March 23, 2004
<b>00-713-I-8</b>	09/974,007 10/10/01	See 00-713-I-1	PENDING
<b>00-713-I-9</b>	09/973,638 10/10/01	See 00-713-I-1	ALLOWED
<b>00-713-I-10</b>	09/973,788 10/10/01	See 00-713-I-1	U.S. Patent No. 6,720,411, issued April 13, 2004
<b>00-713-I-11</b>	09/975,062 10/11/01	See 00-713-I-1	U.S. Patent No. 6,677,122, issued January 13, 2004
<b>00-713-I-12</b>	09/975,376 10/11/01	See 00-713-I-1	PENDING
<b>00-713-I-13</b>	09/975,384 10/11/01	See 00-713-I-1	PENDING

<b>ATTY Case No.</b>	<b>Serial No./ Filing Date</b>	<b>Inventors&gt;Title</b>	<b>Status</b>
00-713-I-14	09/975,498 10/11/01	See 00-713-I-1	ALLOWED
00-713-I-15	09/975,059 11/11/01	See 00-713-I-1	ALLOWED
00-713-I-16	09/976,601 10/12/01	See 00-713-I-1	PENDING
00-713-I-17	09/976,968 10/12/01	See 00-713-I-1	ALLOWED
00-713-I-18	09/976,971 10/12/01	See 00-713-I-1	U.S. Patent No. 6,682,895, issued 1/27/04
00-713-I-19	09/976,863 10/12/01	See 00-713-I-1	PENDING
00-713-I-20	09/976,577 10/12/01	See 00-713-I-1	U.S. Patent No. 6,720,147, issued April 13, 2004
00-713-I-21	09/976,618 10/12/01	See 00-713-I-1	ALLOWED
00-713-I-22	09/981,344 10/15/01	See 00-713-I-1	U.S. Patent No. 6,777,186, issued August 17, 2004
00-713-I-23	09/976,900 10/12/01	See 00-713-I-1	ALLOWED
00-713-I-24	09/976,617 10/12/01	See 00-713-I-1	U.S. Patent No. 6,730,269, filed May 4, 2004
00-713-I-25	09/976,378 10/12/01	See 00-713-I-1	PENDING
00-713-i-26	10/410,324 04/10/03	See 00-713-I-1	PENDING
00-713-L	U.S.S.N. 09/693,005 Filed 10/20/00	Mirkin, Letsinger, Mucic, Storhoff, Elghanian/	U.S. Patent No. 6,495,324, issued 12/17/02

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		NANOPARTICLES HAVING OLIGONUCLEOTI DES ATTACHED THERETO AND USES THEREFORE	
<b>00-713-M</b>	U.S.S.N. 09/693,352 Filed 10/20/00	Mirkin, Letsinger, Mucic, Storhoff, Elghanian/ NANOPARTICLES HAVING OLIGONUCLEOTI DES ATTACHED THERETO AND USES THEREFORE	U.S. Patent No. 6,417,340, issued 7/9/02
<b>00-714-G</b>	U.S. 09/830,620 Filed 8/15/01	Mirkin, Nguyen/ NANOPARTICLES WITH POLYMER SHELLS	PENDING
<b>00-715-A</b>	U.S. 09/760,500 Filed 1/12/01	Mirkin, Letsinger, Mucic, Storhoff, Elghanian, Taton; Garamella, Li/ METHOD OF ATTACHING OLIGONUCLEOTI DES TO NANOPARTICLES AND PRODUCTS PRODUCED THEREBY	U.S. Patent No. 6,767,702, issued July 27, 2004
<b>00-715-B</b>	U.S. 10/716,829 Filed 11/18/03	Mirkin, Letsinger, Mucic, Storhoff, Elghanian, Taton; Garamella, Li/ METHOD OF ATTACHING OLIGONUCLEOTI DES TO NANOPARTICLES AND PRODUCTS PRODUCED THEREBY	Pending
<b>00-1085-A</b>	U.S.S.N.	Mirkin, Letsinger,	U.S. Patent No.

<b>ATTY Case No.</b>	<b>Serial No./ Filing Date</b>	<b>Inventors&gt;Title</b>	<b>Status</b>
	09/820,279 Filed 3/28/01	etc./ METHOD AND MATERIALS FOR ASSAYING BIOLOGICAL MATERIALS	6,750,016, issued June 15, 2004
<b>00-1085-G</b>	U.S.S.N. 10/640,618 Filed 8/13/03	Mirkin,Letsinger, etc./ METHOD AND MATERIALS FOR ASSAYING BIOLOGICAL MATERIALS	Pending
<b>00-1086-A</b>	U.S. 09/903,461 Filed 7/11/01	Letsinger, Garimella/ METHOD OF DETECTION BY ENHANCEMENT OF SILVER STAINING	U.S. Patent No. 6,602,669, Filed 8/5/03
<b>00-1272-C</b>	U.S.S.N. 10/008,978 Filed 12/7/01	Mirkin, Letsinger, Mucic, Storhoff, Elghanian, Taton, Garimella, Li, Park, Lu/ NANOPARTICLES HAVING OLIGONUCLEOTI DES ATTACHED THERETO AND USES THEREOF	PENDING
<b>01-565-A</b>	USSN 10/125,194 Filed 4/18/02	Mirkin, Nguyen, Watson, Park/ OLIGONUCLEOTI DE-MODIFIED ROMP POLYMERS AND CO- POLYMERS	PENDING
<b>01-599-A</b>	U.S.S.N. 10/291,291 Filed 11/08/02	Storhoff/NOVEL THIOL-BASED METHOD FOR ATTACHING OLIGONUCLEOTI DES TO NANOPARTICLES	PENDING
<b>01-661-A</b>	U.S.S.N. 10/034,451	Mirkin, Cao, Jin/ DNA-MODIFIED	PENDING

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<b>ATTY Case No.</b>	<b>Serial No./ Filing Date</b>	<b>Inventors&gt;Title</b>	<b>Status</b>
	Filed 12/28/01	CORE-SHELL AG/AU NANOCRYSTALS	
<b>01-661-C</b>	U.S.S.N. 10/153,483 Filed 5/22/02	Mirkin, Cao, Jin/ DNA-MODIFIED CORE-SHELL AG/AU NANOCRYSTALS	PENDING
<b>01-661-E</b>	U.S.S.N. 10/397,579 3/26/03	Mirkin, Cao, Jin/ DNA-MODIFIED CORE-SHELL AG/AU NANOCRYSTALS	PENDING
<b>01-1565-A</b>	U.S.S.N. 10/266,983 Filed 10/08/02	Park, Taton, Mirkin/ARRAY- BASED ELECTRICAL DETECTION OF DNA USING NANOPARTICLE PROBES	PENDING
<b>01-1633-A</b>	U.S.S.N. 10/266,983 Filed 10/8/02	Park, Taton, Mirkin/NANOPARI CLES HAVING OLIGONUCLEOTI DES ATTACHED THERETO AND USES THEREFOR	PENDING
<b>01-1705-A</b>	U.S.S.N. 10/108,211 Filed 3/27/02	Nam, Park, Mirkin/BIO- BARCODES BASED ON OLIGONUCLEOTI DE-MODIFIED NANOPARTICLES	PENDING
<b>02-338-B</b>	USSN 10/172,428 Filed 6/14/02	Cao, Jin, Nam, Mirkin/MULTICHA NNEL DETECTION USING NANOPARTICLE PROBES WITH RAMAN SPECTROSCOPIC FINGERPRINTS	PENDING

ATTY Case No.	Serial No./ Filing Date	Inventors/Title	Status
02-338-C	10/431,341 5/7/03	Cao, Jin, Nam, Mirkin/MULTICHA NNEL DETECTION USING NANOPARTICLE PROBES WITH RAMAN SPECTROSCOPIC FINGERPRINTS	PENDING
02-1227-A	10/735,357 Filed 12/12/03	DIRECT SNP DETECTION WITH UNAMPLIFIED NUCLEIC ACID USING NANOPARTICLE PROBES	PENDING
03-214-A	10/789,831 Filed 2/27/04	LABEL-FREE GENE EXPRESSION PROFILING WITH UNIVERSAL NANOPARTICLE PROBES IN MICROARRAY ASSAY FORMAT	PENDING
03-466-C	10/854,848 Filed 5/27/04	METHOD FOR DETECTING ANALYTICS BASED ON EVANESCENT ILLUMINATION AND SCATTER- BASED DETECTION OF NANOPARTICLE PROBE COMPLEXES	PENDING
03-666-E	10/877,750 Filed 6/25/04	BIOBARCODE	PENDING